

Remarks:

Reconsideration of the application is requested. Claims 1-9 and 14-21 are now in the application. Claims 1-3, 5, 7-8 have been amended. Claims 10-13 have been canceled. Claims 14-21 have been added.

Support for the amendments to the claims can be found in the following sections.

Claim 1: Support for the addition to 1.b can be found on pg. 8, lines 7-8; support for the addition to 1.b can be found on pg. 7, lines 11-13 and pg. 8, lines 7-8; the subject matter deleted from 1.b is now claimed in new claim 14.

Claim 2. Amended to remove ambiguity, the deleted subject matter is now claimed in new claim 15.

Claim 3. Amended for clarity and to remove ambiguity, the deleted subject matter is now claimed in new claim 16.

Claim 7. Dependency amended to provide proper antecedent basis.

Claims 10, 11, and 12 have been deleted.

Claim 17. Support for the new claim can be found on pg. 8, lines 11-13.

Claim 18. Support for the new claim can be found in the deleted feature of claim 5.

Claim 19. Support for the new claim can be found in claim 6 dependent on the deleted feature of claim 5.

Claim 20. Support for the new claim can be found in claim 7 dependent on claim 6, which is in turn dependent on the deleted feature of claim 5.

In the third paragraph on page 2 of the Office action, the Examiner rejected claims 1-9 and 11-13 as being indefinite under 35 USC § 112, second paragraph.

The Examiner rejected claim 1 for including an optional step: injecting an aqueous solution. As recommended, this limitation has been removed from claim 1 and placed in its own dependent claim, claim 14.

The Examiner rejected claims 2 and 11 for including the term “and/or”. The term has been removed from claim 2 and placed in a new dependent claim, claim 15. Claim 11 has been canceled; so, the rejection is now moot.

The Examiner rejected claim 12. Claim 12 has been canceled; so, the rejection is now moot.

The Examiner rejected claim 13. Claim 13 has been canceled; so, the rejection is now moot.

The Examiner also rejected claim 9 as indefinite. While claim 9 remains in its original form, claims 1 and 8 (on which claim 9 depends) have been amended. The claims have been reworded to clarify that the material helps the pigment (along with cellular fluids) move to the surface of the skin; this contrasts the original wording of “absorbing”. When the material is saline (i.e. claim 9), the saline solution helps to wash the punctured skin. The saline-pigment solution then moves toward the surface of the skin as it is absorbed into the bandage. The material can be solid or gel absorbents as well, for example; *see* claim 8. Claim 9, in light of the amendments to claims 1 and 8, is therefore definite.

Accordingly, the specification and the claims meet the requirements of 35 U.S.C. § 112, second paragraph. Should the Examiner find any further objectionable items, counsel would appreciate a telephone call during which the matter may be resolved. The changes are neither provided for overcoming the prior art nor do they narrow the scope of the claim for any reason related to the statutory requirements for a patent.

In the penultimate paragraph on page 3 of the Office action, the Examiner rejected claims 10-11 as being anticipated by Ring et al. '400 under 35 USC § 102(b). Claims 10-11 have been canceled. Accordingly, the rejection is moot.

In the fourth paragraph on page 4 of the office action, the Examiner rejected claim 12 as being anticipated by Malodobry '107 under 35 USC § 102(e). Claim 12 has been canceled. Accordingly, the rejection is moot.

In the first full paragraph on page 5 of the Office action, the Examiner rejected claims 1-6 and 9 under 35 USC § 103(a) as being unpatentable over Malodobry '107 in view of Ring et al. '400. In addition, the Examiner rejected claim 7 as being unpatentable over Malodobry (US2004/0111107) in view of Ring et al. (US 4,588,400) further in view of Garitano, et al. (US2004/0158296) under 35 USC § 103(a).

Before discussing the prior art in detail, a brief review of the invention as claimed is provided. Amended claim 1 calls for, *inter alia*, a method for removing pigments from a pigmented section of skin that includes the following steps:

- a) providing a skin puncturing device provided with at least one needle;
- b) puncturing the skin at said pigmented section with said skin puncturing device in order to liberate the pigments and cellular fluids from cells containing the pigments;
- c) providing a pad adapted to absorb the pigments and the cellular fluids, said pad containing one or more materials capable of causing the pigments to migrate into an outer layer of the skin; and
- d) bandaging said punctured skin with said pad, thereby causing the pigments at said section to migrate toward the outer layer of the skin.
(Emphasis added by Applicant.)

The present invention as defined in the amended claim 1 is a method of removing pigmentation, specifically tattoos, from an area of skin. The method is based on the known fact that for mature tattoos the pigment particles that were injected into the dermis at the time the tattoo was

created are mostly found inside of cells, which develop around the pigment particles within a few days of the creation of the tattoo. Taking this fact into consideration, the method of the invention therefore essentially comprises two steps: Firstly, the cells containing the pigments are mechanically destroyed with a needle in an analogous manner to that in which the tattoo was originally created, "In order to liberate pigments and cellular fluids from the cells." Secondly, a specially prepared pad containing a material that causes the "pigments at the punctured section to migrate into the outer layer of the skin", i.e. the pad contains a hydroscopic material that draws the aqueous mixture containing the tattoo ink pigment fragments, cellular fluid, and cellular debris to the surface of the skin, where the mixture is absorbed into the pad.

It is essential to understand the scientific basis of the invention in order to appreciate the difference with Malodobry. Therefore, attached are declarations of two experienced dermatologists that support the statements in the previous paragraph relating to the location of the pigment particles that make up the tattoo in the dermis. The declarations being submitted with the response are unsigned. When the signed originals are received from Israel, they will be immediately submitted to the Examiner. If there is any formal problem with the Declarations, the Examiner is asked to telephone the undersigned attorney to remedy the problems without unduly delaying prosecution.

The method taught by Malodobry appears to be superficially similar to that of the present invention since both are based on use of a machine similar/identical to a tattooing machine to penetrate the skin with one or more needles into the dermis where the tattoo pigments reside. However, the two methods actually differ in at least the following significant ways:

Malodobry teaches that, "However, in the treatment according to the invention, no liquid cell substance is evaporated. The vitality of the cell is to be preserved, if possible." [0048] The first sentence is intended to distance his method from that of diathermy. From the second sentence it is clear that Malodobry teaches to make every effort to avoid damage to the cells in the dermis. This is in stark contrast to the method of the present invention in which the object of penetrating the skin is to destroy as many of the pigment containing cells as possible. It appears that in teaching to

preserve the vitality of the cells in the dermis Malodobry is actually teaching away not only from the method of the present invention but also from the goal of his own invention because, as stated previously and in the declarations, it is known and has been known for many years that the pigment particles that must be removed to remove the tattoo are enclosed within cells and can not be effectively released without destroying the cells. Malodobry was apparently unaware of this fact, ignored it, or intends his method to be useful only for removing very newly applied tattoos before the cells have time to grow around the pigment particles.

Malodobry relies on natural processes to cause the fragments to be carried to the skin surface as stated, for example in [0049] "The usual wound healing conveys the color pigment agglomerate fragments to the skin surface where they are then scaled off." This a passive approach compared to the active approach of the method of the present invention, which requires use of a pad comprising a material which causes the pigments to migrate into the outer layer of the skin. Actively drawing the pigments and cell fragments to the surface accelerates the process and also reduces the number of particles that remain behind and are re-trapped in the dermis.

Conclusion: As shown above, Malodobry, on which the Examiner relies for most of his claim rejections, teaches a method that is quite different from that of the invention. If in fact it were possible to follow the teaching of Malodobry and to do minimal damage to the cells in the dermis, then it would not be possible to release the pigment fragments and therefore to remove the tattoo.

Accordingly, because Malodobry '107 in view of Ring et al. '400 does not teach or suggest a method in which cells containing pigment are destroyed, the invention according to claim 1 is patentable over the prior art. Moreover, because the other claims ultimately depend on claim 1, they are patentable as well.

Conclusion

In light of the foregoing remarks, this application is now in condition for allowance and early passage of this case to issue is respectfully requested. If any questions remain regarding this

Applicants: Hazut et al.
Application No.: 10/560,063
Examiner: Neal

amendment or the application in general, a telephone call to the undersigned would be appreciated since this should expedite the prosecution of the application for all concerned.

Petition for extension is herewith made. The extension fee for response within a period of one month pursuant to Section 1.136(a) in the amount of \$60 in accordance with Section 1.17 is enclosed herewith.

No additional fee is believed due. However, please charge any required fee (or credit any overpayments of fees) to the Deposit Account of the undersigned, Account No. 500601 (Docket No. 7640-X05-045).

Respectfully submitted,



Loren Donald Pearson, Reg. No. 42,987
Martin Fleit, Reg. No. 16,900

Customer Number: 27317

FLEIT KAIN GIBBONS GUTMAN BONGINI & BIANCO
21355 East Dixie Highway, Suite 115
Miami, Florida 33180
Tel: 305-830-2600; Fax: 305-830-2605
e-mail: LPearson@FocusOnIP.com